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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,786	07/10/2003	Thomas Edward Priebe	169.12-0588	3493

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EXAMINER	
STINSON, FRANKIE L	
ART UNIT	**PAPER NUMBER**
1792	

MAIL DATE	DELIVERY MODE
10/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/616,786	PRIEBE ET AL.	
	Examiner	Art Unit	
	FRANKIE L. STINSON	1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 August 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 6, 16, 17, 18, 20, 21, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Koo (U. S. Pat. No. 5,829,278) or Japan'882 (Japan 2001-128882) in view of either Taylor et al. (U. S. Pat. No. 5,797,318), Taylor (U. S. Pat. No. 5,680,987).

Re claims 6, 18 and 26, Koo and Japan'882 are each cited disclosing a device for moistening material, the device comprising:

a chamber (2 in Koo and 1 in Japan'882);

a rack (59 in Koo and 28 in Japan'882) positioned in the chamber for holding the material;

a liquid supply of a liquid 3 in Koo and 34A in Japan'882);

an applicator (35 in Koo and 33 in Japan'882) in the chamber for applying the liquid to the material; and

a delivery system (37 in Koo and 35 in Japan'882) for delivering the liquid from the supply to the applicator that differs from the claims only in the recitation of the material being a cleanroom material and control system controlling the amount of liquid applied to the material based on a parameter related to the target saturation level, based upon a user input of the material. The patents to Taylor'318 (col. 9, lines 52-61) and Taylor'987 (see abstract) are both cited disclosing the an arrangement including a textile material,

where there is provided a control system controlling the amount of the amount of liquid applied to the textile material based on a parameter related to the target saturation level, based upon a user input of the textile material. It therefore would have been obvious to one having ordinary skill in the art to modify the device of either Koo or Japan'882, to include a control system as taught by either Taylor'987 or Taylor'318, since Koo discloses that the degree of moisture is the be controlled (col. 3, lines 13-24). It is old and well known to produce wet/moist towels, having varying moisture content , depending upon the specific use towel. As for the cleanroom material, while not specifically disclose by the applied prior art, the same is of little patentable weight in that, the same structure is disclosed and is therefore capable of being used as claimed. All of the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

See MPEP 2114
APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE FROM THE PRIOR ART
>While features of an apparatus may be recited either structurally or functionally, claims<directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function. >In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429,1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to

function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971);< In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).“ [A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch &
Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis
in original).

MANNER OF OPERATING THE DEVICE DOES NOT DIFFERENTIATE APPARATUS CLAIM FROM THE PRIOR ART
A claim containing a “ recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim
1 recited that the apparatus was “ for mixing flowing developer material” and the body of the claim recited “ means for mixing ..., said mixing means being stationary and completely submerged in the developer material” . The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.)..

Re claim 10, Koo and Japan'882 disclose the rack. Re claims 16 and 17, Koo and Japan'882 discloses the draining means. Re claims 20 and 21, to include a plurality of nozzle is deemed d to be a mere duplication of parts (MPEP 2144.04 REVERSAL, DUPLICATION OR RE-ARRANGEMENT OF PARTS). Re claims 27, Japan'882 discloses the pressure applicator (20).

3. Claims 7, 8, 9, 11, 12, 13, 14, 15, 22, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the applied prior art as applied to claim 6, 18 and 26 above, and further in view of Vuncannon (U. S. Pat. No. 4,717,870).

Re claims 7, 8, 9, 11, 12, 13, 14, 15, 22, 23 and 24, the patents to Koo, Japan'882 and Taylor are cited as applied above, and thusly differs from Koo, Japan'882 and Taylor only in the recitation of the parameter being the conductivity. Vuncannon discloses the electrical conductivity (col. col. 3, lines 56-59) control means as claimed. It therefore would have been obvious to one having ordinary skill in the art to modify the arrangement of Koo, Japan'882 in view of Taylor, to be as taught by Vuncannon, since this is considered to be a mere substation of equivalents. It is noted that since automated control means are disclosed, to program the same to control as a function of conductivity, is of little patentable weight. Clearly since all of the structure is disclosed, the same is clearly capable of functioning as claimed with the proper programming.

4. Claims 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over the applied prior art as applied to claims 6, 18 and 26 above, and further in view of Chen (U. S. Pat. No. 6,668,843).

Claim 19 defines over the applied prior art only in the recitation of the applicator being movable with respect to the rack. Chen discloses the applicator as claimed. It therefore would have been obvious to one having ordinary skill in the art to modify the applicator of either Koo or Japan'882, to be as taught by Chen, for the purpose of ensuring for the distribution of the moistening liquid.

5. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection. However, in regard to the remarks that the applied prior art is not in the field of endeavor of applicant's invention, namely a device for moistening cleanroom material (instantly disclosed as "swabs, fabrics, cloths and paper") it should be noted that given the fact that the claims contain absolutely no structure to limit the material for cleanrooms only, the disclosure of the applied prior art is reasonably pertinent to the moistening of swabs, fabrics, cloths and paper, irrespective of the intended use.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANKIE L. STINSON whose telephone number is (571) 272-1308. The examiner can normally be reached on M-F from 5:30 am to 2:00 pm and some Saturdays from approximately 5:30 am to 11:30 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr, can be reached on (571) 272-1700. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

fls

FRANKIE L. STINSON
Primary Examiner
GROUP ART UNIT 1792